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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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|-----------------|-------------|----------------------|---------------------|

09/482,773    01/13/00    DREHER

J    2870/220

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| EXAMINER |
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HM22/0313

Estelle J Tsevdos Ph D J D  
Kenyon & Kenyon  
One Broadway  
New York NY 10004

|                       |              |
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| BERMAN, A<br>ART UNIT | PAPER NUMBER |
|-----------------------|--------------|

1619  
DATE MAILED:

03/13/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Office Action Summary**

Application No.

09/482,773

Applicant(s)

DREHER, JOHN D.

Examiner

Alysia Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 April 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1,2.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

### DETAILED ACTION

1. Receipt is acknowledged of the information disclosure statement filed April 3, 2000. Claims 1-34 are pending.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 6, 7, and 20-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claims 6 and 7 are indefinite because it is unclear how they further limit claim 1. Claim 6 requires that the composition further comprise at least one inorganic, non-matte, non-spherical powder. Claim 7 lists titanium oxide coated mica as a suitable powder according to claim 6. Titanium oxide coated mica is also an interference pigment. A composition comprising titanium oxide coated mica would read on a composition comprising an interference pigment and a powder as in claim 6. Therefore, it is unclear how requiring an inorganic, non-matte, non-spherical powder, which may also be an interference pigment, further limits claim 1.
5. Claims 6, 12-14, 17-20 and 24 are rejected because the term "non-matte" is indefinite. The specification provides some examples of what is encompassed by this

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term but does not provide guidance with regard to what is excluded. The metes and bounds of the claim cannot be determined because it is unclear what is excluded.

6. Claims 20-34 are indefinite because claims 20, 32 and 33 recite percents of components but do not provide units of measurement. Are these percents by weight, volume, solids content, etc.? Clarification is requested.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8. Claims 1-8 and 12-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Kimura et al. (US 5,690,916).

Kimura et al. disclose cosmetic composition comprising a coherent light component (interference pigment) that provides interference action when applied to the skin (col. 2, lines 16-21). The interference pigment is preferably titanium oxide coated mica (col. 2, lines 32-33). The reference teaches that the interference pigment may exhibit a blue color when desired to mask a specific skin defect (col. 4, line 65 to col. 5, line 4 and col. 5, lines 19-26). For additional interference pigment, see column 6, lines 57-65. Iron oxide may be coated onto the interference pigment (col. 7, lines 22-29).

Additional powders that may be incorporated into the composition are inorganic powders such as mica, muscovite, synthetic mica, boron nitride, titanium dioxide, iron oxide, titanium oxide coated talc, titanium oxide coated mica, bismuth oxychloride, aluminum powder, *inter alia* (col. 9, lines 18-60). In Table 2 at column 14, Kimura exemplifies compositions comprising titanium oxide coated mica that exhibits a blue interference color with titanium dioxide, iron oxide and mica. See also Tables 4, 6 and 8. Example 13 at column 28 exemplifies a powdery foundation for adjusting light blue hyperchromic portions of the skin that comprises talc, sericite, titanium oxide coated mica that exhibits a blue interference color and red, yellow and black iron oxides. See also claims 1-6.

Kimura et al. teaches a cosmetic composition comprising an interference pigment that exhibit a blue interference color, metal oxides such as titanium dioxide and iron oxides and inorganic, non-matte, non-spherical powders such as bismuth oxychloride as instantly claimed. Kimura teaches that these compositions can be applied to the skin in order to hide hyperchromic portions of the skin. The application of these compositions to the skin inherently reduces the appearance of lines and wrinkles on the skin.

9. Claims 1-5, 9, 21-23, 25, 26 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by WO 99/66883 ('883).

WO '883 discloses a composition for topical application of the skin that comprises at least one interference pigment and at least one non-interference pigment. The compositions reduce the appearance of flaws and defects in the skin. See the abstract. WO '883 discloses that the most common interference pigments are micas

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layered with 50-300 nm films of titanium dioxide, iron oxide or chromium oxide (page 4, lines 26-27). Examples of these pigments are those sold under the trade names Timiron™ and Flamenco™, *inter alia* (page 4, line 30 to page 5, line 2). The amount of interference pigment in the compositions is from about 0.05 to 90% by weight, with most products containing from about 0.5 to 15% (page 5, lines 11-22).

Additional pigments that may be incorporated into the compositions are, for example, iron oxides (page 5, lines 33-34) and titanium dioxide (page 6, line 1). The amount of these pigments in the compositions is about 1-20% by weight of the composition (page 6, lines 21-23). Additional powders that may be incorporated into the composition in an amount from 0.001 to 20% by weight (page 6, line 31 to page 7, line 8). One such powder is the inorganic powder calcium aluminum borosilicate. Example 1 at page 10 teaches a composition comprising titanium dioxide coated mica, iron oxides and titanium dioxide. See also claims 1, 3 and 6-8. The reduction of the appearance of lines and wrinkles on the skin as instantly claimed is encompassed by the teaching in WO '883 of the reduction of flaws and defects of the skin.

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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11. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Kimura et al. or WO '883 each in view of the other.

Kimura et al. teaches all the limitations of the claims as stated above. It does not teach about 1-9% by weight of interference pigment, about 0.1 to 30% of a metal oxide and about 2-20% of bismuth oxychloride. WO '883 teaches all the limitations of the claims as stated above. It does not teach inorganic, non-matte, non-spherical powders.

Kimura et al. teaches inorganic, non-matte, non-spherical powders such as bismuth oxychloride as stated in the 35 U.S.C. 102(b) rejection above. WO '883 teaches a weight percent of components within the instantly claimed ranges as stated in the 35 U.S.C. 102(e) rejection above. WO '883 further teaches at page 5, lines 19 to 22 that it is within the skill in the art to determine an optimum concentration of interference pigment in order to achieve a desired effect. Each reference makes up the deficiencies of the other.

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare either the composition of Kimura et al. using the amounts of components as taught by WO '883 or the composition of WO '883 and add bismuth oxychloride as taught in Kimura et al. with the reasonable expectation of providing a cosmetic composition that reduces the appearance flaws and defects of the skin.

### ***Correspondence***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-


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4638. The examiner can normally be reached on Monday through Friday from 8:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on 703-308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 or 703-305-4456 for regular communications and 703-308-7922 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.

  
Alysia Berman  
Patent Examiner  
March 3, 2001

  
DIANA DUDASH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600